DETAILED ACTION

1.   This communication is a first Office Action Non-Final rejection on the merits.

Claims 1-8, as originally filed, are currently pending and have been considered below.

Specification

2.   Applicant is reminded of the proper language and format for an abstract of the
disclosure.

The abstract should be in narrative form and generally limited to a single
paragraph on a separate sheet within the range of 50 to 150 words. It is important that
the abstract not exceed 150 words in length since the space provided for the abstract
on the computer tape used by the printer is limited. The form and legal phraseology
often used in patent claims, such as "means" and "said," should be avoided. The
abstract should describe the disclosure sufficiently to assist readers in deciding whether
there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information
given in the title. It should avoid using phrases which can be implied, such as, "The
disclosure concerns," "The disclosure defined by this invention," "The disclosure
describes," etc.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current

U.S. practice. They appear to be a literal translation into English from a foreign

document and are replete with grammatical and idiomatic errors.

For claims 1 and 5, the preamble is directed toward a system claim but the system seems to comprise the steps of a method claim. It is unclear to the examiner whether the claim is directed toward a system or a method.

Further in claims 1 and 5, the recited term "certain period of time" renders the claim indefinite. It is unclear to the Examiner what the period of time is and how the specific period of time changes the structure of the system or alters the steps of the method. Further it being a "certain" time is unclear because what is that time?

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. 35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter *or* any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap *two* different statutory classes of invention as set forth in 35 USC 101. The claim begins as a system (ex. Preamble of claim 1), however, the limitations identify the structure by method steps, for example, extraction step...examination step. (See above rejection of claims under 35 USC 112, second paragraph, for specific details regarding this issue). "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

Claims 1-8 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would <u>not</u> qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Thus, claims 1-8 are non-statutory since they may be preformed within the human mind, the steps of extracting information, examination, approval, determination and updating are not done by a computer. While they include a database, a database by itself is nothing more then a collection of data and is not considered to be an apparatus.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   **Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by**

Doyle et al. (5,694,551).

        As per claim 1, Doyle et al. discloses a parts integrated control system

adaptable to a life cycle, comprising a master database (Col. 3, lines 9-16; disclose that

the system includes a master or central database which disclose a parts list or catalog

information), in which data on all parts including parts for new commercial products is

previously existing, and which may be shared among related department terminal

devices (Col. 3, lines 17-23; disclose that the central database is connected to other

databases where are located on customer terminals where information can be

exchanged); a parts integration database, which permits an exchange of data to and

from said master database (Col. 3, lines 17-23; disclose that the central database is

connected to other databases where are located on customer terminals where

information can be exchanged); and an examiner terminal device and an authorized

approver terminal device, which are connectable to said parts integration database (Col.

3, lines 17-23; disclose that the central database is connected to other databases where

are located on customer terminals where information can be exchanged, from this it is

shown that the central database is connected to customer terminals which could be any

sort of terminals examiner or authorized approver, Col. 3, lines 36-40; discloses that the

employee has to be an authorized user of the system), wherein said parts integrated

control system also comprises:

an extraction step of extracting parts-related data having been newly recorded in

said master database within a certain period of time to copy the extracted new parts

data into said parts integration database (Col. 7, lines 7-18; discloses that the system is

capable of extracting information from a set of data, and maintained or copied to the

main or central database, what the information is considered to be non functional since

it does not change the structure of the system as claimed, further since the time period

is not claimed it could be done in any time period);

an examination step of comparing the new parts data obtained through said

extraction step with existing parts-related data to allow an examiner to examine whether

the integration of the existing parts and the new parts is possible or not (Col. 9, lines 13-

21; disclose that the system is capable of comparing extracted data, fact that it allows

some one to do something is irrelevant since no determination is actively made in this

step, it is simply comparing information for a later step);

an approval request step of sending a request to approve a resulting judgment,

which is passed by the examiner through said examination step when the integration of

the existing parts and the new parts is judged to be possible, to said authorized

approver terminal device dedicated to an authorized approver who is authorized to

make a final decision on the judgment of the examiner (Col. 3, lines 36-40; disclose the

people able to update the system have to be an authorized user which would approve

changes or updates in the system, Col. 9, lines 13-21; disclose that the authorized user can change product information in the catalog and by doing this they have approved or disapproved of the change by either choosing to update the system or not);

a determination step of allowing the authorization approver to determine the possibility or not of the integration of the existing parts and the new parts in accordance with said approval request step (Col. 9, lines 13-21; disclose that the system allows a authorized person to enter information and change existing information, since this step is not actively authorizing the approver it is taken that the system need only allow for authorization of be capable of authorizing which it is); and

an updating step of providing integrated parts data by updating said new parts data and/or the existing parts-related data in said master database on the basis of approval data obtained at a time when the approval for the integration of the existing parts and the new parts is determined through said determination step (Col. 9, lines 13-21; discloses that the system updates the database information based on the input from the authorized user).

As per claim 2, Doyle et al. discloses the above-enclosed invention, Doyle et al. further discloses wherein it further comprises a distribution step of distributing the integrated parts data provided by updating through said updating step to the related department terminal devices (Col. 4, lines 28-34; disclose that the system in updated periodically and that the information is distributed from the central database to the customer databases located on the customer terminals).

As per claim 3, Doyle et al. discloses the above-enclosed invention, Doyle et al. further discloses wherein it further comprises a recording step of recording into said parts integration database, data on a resulting judgment passed by the examiner through said examination step when the integration of the existing parts and the new parts is judged to be impossible, together with a reason to judge said integration to be impossible (Col. 3, line 65 thru Col. 4, line 3; discloses that the information is added to the system or recorded in the system periodically, the information itself such as that parts data and the judgment is considered non functional descriptive material and adds no structure to the system as claimed, since nothing is done with this information it is simply stored);

As per claim 4, Doyle et al. discloses the above-enclosed invention, Doyle et al. further discloses wherein it further comprises a recording step of recording into said parts integration database, data on a resulting rejection determined by the authorized approver through said determination step when the approval for the integration of the existing parts and the new parts is rejected, together with a reason to reject the approval for the integration (Col. 3, line 65 thru Col. 4, line 3; discloses that the information is added to the system or recorded in the system periodically, the information itself such as that parts data and the judgment is considered non functional descriptive material and adds no structure to the system as claimed, since nothing is done with this information it is simply stored).

As per claim 5, Doyle et al. discloses a parts sales mode control system adaptable to a life cycle comprising a master database (Col. 3, lines 9-16; disclose that

the system includes a master or central database which disclose a parts list or catalog information), in which data on all parts including parts for new commercial products are previously existing, and which may be shared among related department terminal devices (Col. 3, lines 17-23; disclose that the central database is connected to other databases where are located on customer terminals where information can be exchanged); a parts sales mode control database, which permits an exchange of data to and from said master database (Col. 3, lines 17-23; disclose that the central database is connected to other databases where are located on customer terminals where information can be exchanged); and an examiner terminal device and an authorized approver terminal device, which are connectable to said parts sales mode control database (Col. 3, lines 17-23; disclose that the central database is connected to other databases where are located on customer terminals where information can be exchanged, from this it is shown that the central database is connected to customer terminals which could be any sort of terminals examiner or authorized approver, Col. 3, lines 36-40; discloses that the employee has to be an authorized user of the system), wherein the parts sales mode control system also comprises:

an extraction step of extracting parts-related data having been newly recorded in said master database within a certain period of time to copy extracted new parts data into said parts sales mode control database (Col. 7, lines 7-18; discloses that the system is capable of extracting information from a set of data, and maintained or copied to the main or central database, what the information is considered to be non functional

since it does not change the structure of the system as claimed, further since the time
period is not claimed it could be done in any time period);

an examination step of comparing the new parts data obtained through said
extraction step with existing parts-related data to allow an examiner to examine whether
a change of the sales mode on the existing parts is possible or not (Col. 9, lines 13-21;
disclose that the system is capable of comparing extracted data, fact that it allows some
one to do something is irrelevant since no determination is actively made in this step, it
is simply comparing information for a later step);

an approval request step of sending a request to approve a resulting judgment,
which is passed by the examiner through said examination step when the change of the
sales mode on the existing parts is judged to be possible, to the authorized approver
terminal device dedicated to an authorized approver who is authorized to make a final
decision on the judgment of the examiner (Col. 3, lines 36-40; disclose the people able
to update the system have to be an authorized user which would approve changes or
updates in the system, Col. 9, lines 13-21; disclose that the authorized user can change
product information in the catalog and by doing this they have approved or disapproved
of the change by either choosing to update the system or not);

a determination step of allowing the authorized approver to determine the
possibility or not of the change of the sales mode on the existing parts in accordance
with said approval request step (Col. 9, lines 13-21; disclose that the system allows a
authorized person to enter information and change existing information, since this step

is not actively authorizing the approver it is taken that the system need only allow for

authorization of be capable of authorizing which it is); and

    an updating step of providing changed sales mode data by updating the existing

parts sales mode-related data in said master database on the basis of approval data

obtained at a time when the approval for the change of the sales mode on the existing

parts is determined through said determination step (Col. 9, lines 13-21; discloses that

the system updates the database information based on the input from the authorized

user).

    As per claim 6, Doyle et al. discloses the above-enclosed invention, Doyle et al.

further discloses wherein further comprises a distribution step of distributing the

changed sales mode data provided by updating through said updating step to said

related department terminal devices (Col. 4, lines 28-34; disclose that the system in

updated periodically and that the information is distributed from the central database to

the customer databases located on the customer terminals).

    As per claim 7, Doyle et al. discloses the above-enclosed invention, Doyle et al.

further discloses wherein it further comprises a recording step of recording, into said

parts sales mode control database, data on a resulting judgment passed by the

examiner through said examination step when the change of the sales mode on the

existing parts is judged to be impossible, together with a reason to judge the change of

the sales mode to be impossible (Col. 3, line 65 thru Col. 4, line 3; discloses that the

information is added to the system or recorded in the system periodically, the

information itself such as that parts data and the judgment is considered non functional

descriptive material and adds no structure to the system as claimed, since nothing is done with this information it is simply stored).

      As per claim 8, Doyle et al. discloses the above-enclosed invention, Doyle et al. further discloses wherein it further comprises a recording step of recording, into said parts sales mode control database, data on a resulting rejection determined by the authorized approver through said determination step when the approval for the change of the sales mode on the existing parts is rejected, together with a reason to reject the approval for the change of the sales mode (Col. 3, line 65 thru Col. 4, line 3; discloses that the information is added to the system or recorded in the system periodically, the information itself such as that parts data and the judgment is considered non functional descriptive material and adds no structure to the system as claimed, since nothing is done with this information it is simply stored).

Conclusion

      Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL R. FISHER whose telephone number is (571)270-5097. The examiner can normally be reached on Mon/Fri [7:30am/5pm] with first Fri off.

      If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PRF

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689